

REMARKS

Reconsideration is requested.

The Examiner has withdrawn the allowability of claims 11-12 and 14 in view of U.S. Patent No. 5,252,504 to Lowrey et al. The Examiner admits that Lowrey fails to teach three different transistors having three different threshold voltages. The Examiner states that the courts have held that mere duplication of parts has no patentable significance unless a new or unexpected result is produced, and is relying on *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

The court in *Harza* stated that the only difference between the reference's structure for sealing concrete and that of *Harza*'s claim 1 was that the reference's structure had only a single rib (i.e., arm) on each side of a web, whereas the claim required a plurality of such ribs. See *Harza*, 274 F.2d at 671, 124 USPQ at 380. The court stated that "[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here."

The Examiner did not compare the facts in *Harza* with those in the present case and explain why, based upon this comparison, the legal conclusion in the present case should be the same as that in *Harza*. Instead, the Examiner relies upon *Harza* as establishing a per se rule that duplication of parts is obvious. As stated by the Federal Circuit in the more recent case of *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on per se rules of obviousness is legally incorrect and must cease."

For a prima facie case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA1976).

The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a prima facie case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. The Examiner has not provided any reason why one of ordinary skill in the art would have included three different transistors having three different threshold voltages.


The Examiner has not explained why the Lowrey reference itself would have fairly suggested, to one of ordinary skill in the art, the desirability of three different transistors with three different threshold voltages rather than Lowrey's two transistors.

For the above reasons, the Examiner has not established a prima facie case of obviousness of the claimed invention. For an indication of how the Board of Appeals might decide this issue if the rejection is maintained, the Examiner's attention is directed to the unpublished decision in *Ex parte Ernst Hendrik August Granneman, Albert Hasper and Jan Zinger*, Appeal No. 2002-1760, Application No. 09/355,509, heard February 19, 2003.

Further, it is respectfully submitted that transistors having different threshold voltages are not duplicate parts, but are in fact different parts.

In view of the foregoing, withdrawal of the rejection of claims 11-12 and 14 and allowance of claims 11-12 and 14 is requested.

The undersigned is available for telephone consultation at any time.

Dated: December 1, 2004 By: Respectfully submitted,  
  
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